

REMARKS

Applicant wishes to thank the Examiner for the attention accorded to the instant application, and respectfully requests reconsideration of the application as amended.

Formal Matters

Claims 28, 29, 32, and 33 are pending in the application.

Double Patenting

Claims 28, 29, 32 and 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 30, 31, 37 and 38 of co-pending Application No. 11/410,327, respectively. Applicant submits herewith a Terminal Disclaimer To Obviate a Provisional Double Patenting Rejection Over a Pending Reference Application, and respectfully requests that this rejection be withdrawn.

Rejection of Claims Under 35 U.S.C. §103

Claims 28, 29, and 33 are rejected under 35 U.S.C. § 103(a) as unpatentable over Lynch et al., U.S. Patent No. 5,761,618 (hereinafter “Lynch”) in view of Sturniolo et al., U.S. Patent No. 6,201,962 (hereinafter “Sturniolo”) and further in view of Daly, U.S. Patent No. 6,122,503. Claim 32 was rejected under 35 U.S.C. §103(a) as unpatentable over Lynch in view of Sturniolo in view of Daly and further in view of Grandhi et al., U.S. Patent No. 6,125,280 (hereinafter “Grandhi”). These rejections should be withdrawn based on the comments and remarks herein.

The Examiner acknowledges that Lynch does not teach or suggest wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network, as recited in claims 28, 29, 32 and 33 (see Office

Action, page 6). However, the Examiner asserts that Sturniolo teaches this feature. Applicant respectfully disagrees.

Sturniolo teaches mobile communication systems involving multiple local area networks and wide area networks (column 1, lines 19-21). In particular, Sturniolo discloses “According to the present invention, however, mobile terminals 36 also seamlessly roam from one network to another network without a need to terminate and reestablish an end to end session between the mobile terminal 36 and a device coupled to one of the networks... However, when the mobile terminal 36 moves outside of the cell coverage of access point AP1 and into the cell coverage of an access point 28 (AP2) included in LAN2, the mobile terminal 36 newly registers with the access point AP2” (column 6, lines 39-56). Sturniolo does not teach or suggest a method by which the mobile terminal determines a new access point with which to register. Instead, Sturniolo states “Assuming the mobile terminal 36 has roamed within the cell coverage of the access point AP2, the mobile terminal 36 will thus be able to register with the access point AP2 (column 10, lines 24-26).” Thus, Sturniolo does not teach or suggest a mobile device receiving a message informing the device that one or more network identifiers are available for potential handover; Sturniolo merely assumes that access point AP2, for example, is available.

In addition, the Examiner points to Sturniolo’s disclosure “As a result, the mobile terminal 36 receives a new network identification or address by virtue of becoming registered within LAN2” (column 6, lines 53-56), and contends that this teaches the feature “wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and said receiving of said message occurs without said user equipment searching said mobile communication network”. However, the “network identification or address” disclosed in Sturniolo is not an identifier for identifying the network.

The network identification or address disclosed in Sturniolo is an identifier for identifying user equipment, e.g., a mobile device or mobile terminal, which is clear from the description, “Next, in step 54 the mobile terminal 36 obtains a network identification (ID)/address. Such network ID may be obtained via any of several known conventional techniques in which a unique network ID is assigned to each particular mobile terminal 36 within the LAN1” (column 7, lines 57-61).

Both Daly and Grandhi fail to cure the above-described deficiencies of Lynch and Sturniolo, and the Examiner does not state otherwise.

It has been held by the courts that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As illustrated above, the hypothetical combination of Lynch and Sturniolo and Daly and Grandhi, taken singly or in any combination, does not disclose or suggest wherein said mobile communication network signals one or more of the plurality of network identifiers available for the potential handover, and receiving a message on a user equipment without said user equipment searching said mobile communication network, and does not teach or suggest each and every feature of the present invention as recited in claims 28, 29, 32, and 33. Thus *prima facie* obviousness has not been established, so that these claims patentably distinguish over the art of record in the application.

Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

For at least the reasons set forth in the foregoing discussion, Applicant believes that the Application is now allowable, and respectfully requests that the Examiner reconsider the rejection and allow the Application. Should the Examiner have any questions regarding this Amendment, or regarding the Application generally, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,



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